

Atty Dkt. No.: 10011076-1  
USSN: 10/087,035

### **REMARKS**

In view of the amendments to the claims above and the following remarks, the Examiner is requested to allow 1-11, 22, 27, 28, 31-37, and 41-44.

New Claims 42-44 have been added to recite that curating comprises checking the sequence for errors, removal of commonly repeated subsequences, and/or removal of any artifacts associated with sequence assembly.

Support for the amendment appears, for example, at paragraph [0071] of the specification. Because no new matter is added by way of these amendments, entry thereof by the Examiner is respectfully requested.

### ***Claim Objections***

The Examiner has again objected to the placement of commas in Claim 9. The Examiner asserted that her objections are objective in that the commas are improper grammatically. Without a citation of a document by the Examiner to support such an assertion, it is a subjective opinion and preference of the Examiner. The Examiner is again reminded that some latitude in the manner of expression should be permitted, and Examiners should not insist on their own preferences if the mode of expression selected by Applicant satisfies 35 U.S.C. § 112, 2<sup>nd</sup> paragraph. MPEP § 2173.02.

Withdrawal of this objection is respectfully requested.

### ***Claim Rejections – 35 U.S.C. § 102***

Claims 1-11, 22, 27, 28, and 31-41 were rejected under 35 U.S.C. § 102(e)(1) as allegedly being anticipated by US Patent Application Publication No. 2003/0120432 to Zhou et al. (hereinafter "Zhou"). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Moreover, an anticipation rejection that is based on inherency must be supported by factual and technical grounds establishing that the inherent feature

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must flow as a necessary conclusion, not simply a possible conclusion, from the teaching of the cited art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990); *In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

The Examiner asserted "that the terms 'curating' and 'sequencing' can be interpreted broadly...." Final Office Action at page 9. Further, the Examiner asserted that manufacturing the chip (page 4 of Zhou) represents curating a sequence.

The Examiner is reminded that during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. MPEP § 2173.05(a).

Applicant's specification at paragraph [0071] states that:

[s]equence curation typically involves checking the raw sequences from event 150 for errors such as incorrect sequences and incorrect 5'-3' ordering of sequences. Sequence curation 160 may also include removal of commonly repeated subsequences such as ALU and the like which would give rise to non-specific probes, and removal of any artifacts associated with sequence assembly, such as residual vector sequences (emphasis added).

Moreover, the ordinary dictionary definition for *curation* is curing or healing. In the Advisory Action dated February 27, 2006, the Examiner asserted that the word curation does not appear in the claims. However, the essential meaning of a word does not change if the word is a present participle/gerund or a noun. The noun is merely the act of doing what the present participle/gerund recites, and the two parts of speech are often synonymous and interchangeable. For example, elongation is the act of elongating. The essential definition of the two words is the same, i.e. drawing out or lengthening. Thus, a definition of one of the two parts of speech can serve as a definition of the other.

The Examiner further asserted in the Advisory Action that the definition of *curating* at paragraph [0071] of Applicant's specification is not a clear and concise definition, but rather is an exemplification by virtue of the *such as* language. The *such as* language has been highlighted in the recitation of paragraph [0071] above for purposes of discussion. It should be apparent from paragraph [0071] that three embodiments of sequence curation are each disclosed, and then each embodiment is followed by *such as* language. Thus, the passage discloses:

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1. checking the raw sequences from event 150 for errors;
2. removal of commonly repeated subsequences; and
3. removal of any artifacts associated with sequence assembly.

These are clear and concise descriptions of curation as defined by Applicant, and are not exemplifications. New Claim 42 recites these meanings of curation.

Therefore, the Examiner's continued broad interpretation of the word *curating* is inconsistent both with Applicant's specification and with the ordinary meaning of the word. Curation is not manufacturing. A mechanic who tunes an engine is not manufacturing the engine. Accordingly, Zhou does not disclose curating a sequence for a gene of interest.

In addition, Zhou does not disclose selecting (or selection) by the customer of at least one array design parameter, such as a probe selected specifically for a gene that is also selected by the customer. In Zhou (and in the provisional applications 60/288,429, 60/265,103, and 60/265,013 to which Zhou claims priority), the customer identifies probes that have been pre-selected by the vendor to include on an array. These vendor-selected probes come from the confines of the vendor's existing database. They are not probes selected by the customer specifically for the gene that is selected by the customer. In Zhou, if the vendor's database does not contain a probe for the customer-selected gene of interest, curating the gene sequence followed by selection of at least one probe specific for the curated sequence will fail, which means that Zhou is not disclosing Applicant's claimed invention. Applicant agrees with the Examiner's statement in the Advisory Action that the method steps must be present in the cited document. However, the Examiner has not established that the steps are in fact present in Zhou. The Examiner is reminded of the standard for inherency (recited above). An inherent feature must flow as a necessary conclusion, not simply a possible conclusion, from the teaching of the cited art. The Examiner appears to be relying on a mere possibility that the customer-selected probe is present in Zhou's database.

Accordingly, Zhou does not identically disclose each and every element of Applicants' invention. As such, there is no anticipation. Withdrawal of this rejection is respectfully requested.

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**CONCLUSION**

In view of the amendments and remarks provided above and in the Amendment and Response to the Final Office Action filed February 9, 2006, Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10011076-1.

Respectfully submitted,



Date: April 10, 2006

By: \_\_\_\_\_

Richard A. Schwartz  
Registration No. 48,105

AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, CO 80537-0599

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